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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,698	03/18/2004	Michael E. Miller	65937-0047	6051
10291 7590 10/31/2007 RADER, FISHMAN & GRAUER PLLC 39533 WOODWARD AVENUE SUITE 140 BLOOMFIELD HILLS, MI 48304-0610			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No. **11**

10/803,698

Applicant(s)

MILLER ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006 and 30 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 17-20 and 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

New grounds of rejection are contained within this Office Action. Accordingly this action has been made Non-Final.

#### ***Election/Restrictions***

1. Claims 1 – 8, 17 – 20 and 25 – 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/30/07.
2. Applicant's election with traverse of invention II in the reply filed on 5/30/07 is acknowledged. The traversal is on the ground(s) that a thorough search of the elected subject matter would encompass a search for the nonelected subject matter and no serious burden would be present. This is not found persuasive because the subject matter of invention I includes limitations not found in invention II such as a biopsy device having a handpiece. Thus, a separate search would need to be performed.

The requirement is still deemed proper and is therefore made FINAL.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 21 recites the limitation "the tissue receiving opening" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 9, 10, 12, 14, 15 and 21 – 24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,871,487 to Warner et al.

In regard to claims 9, 10, 12, 14, 15 and 21 – 24, Warner et al. disclose a base (12); a cradle (32) movably mounted to the base; and an indexing guide moveable with the cradle and including a receptacle (36) within which a portion of the medical instrument is received, the indexing guide configured to inhibit rotation and axial movement of the portion of the medical instrument received in the receptacle relative to the indexing guide and the cradle when the medical instrument is locked therein (Col. 4, lines 44 – 46). The indexing guide includes at least one guide lock (38) that is selectively engagable with the portion of the medical instrument received within the receptacle to inhibit rotation and axial movement thereof. The guide lock is moveably secured to the indexing guide. The indexing guide includes a lip adjacent the receptacle (Figure 1). The cradle includes a pivotable clamp (38) selectively engagable with the medical instrument to inhibit rotation and axial movement.

8. Claims 9, 10 - 12, 14 - 16 and 21 – 24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,451,027 to Cooper et al.

In regard to claims 9, 10 - 12, 14 - 16 and 21 – 24, Cooper et al. disclose a base (18); a cradle (20) movably mounted to the base; and an indexing guide (22) moveable with the cradle and including a receptacle within which a portion of the medical instrument is received, the indexing

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guide configured to inhibit rotation and axial movement of the portion of the medical instrument received in the receptacle relative to the indexing guide and the cradle when the medical instrument is locked therein. The indexing guide includes at least one guide lock that is selectively engagable with the portion of the medical instrument received within the receptacle to inhibit rotation and axial movement thereof. The guide lock is moveably secured to the indexing guide. The indexing guide includes a lip adjacent the receptacle. The cradle includes a pivotable clamp selectively engageable with the medical instrument to inhibit rotation and axial movement (Col. 8, line 43 – Col. 9, line 37). Cooper et al. disclose a deployment mechanism configured to move the cradle relative to the base (Col. 10, lines 10 – 14).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,871,487 to Warner et al.

In regard to claim 11, Warner et al. disclose the indexing guide including a guide lock, but fails to disclose two guide locks. However, duplicating the components of a prior art device is a design consideration within the skill of the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the guide lock as disclosed by Warner et al. to more securely hold the medical instrument in place.

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11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,871,487 to Warner et al. in view of U.S. Patent No. 7,166,114 to Moctezuma De La Barrera et al.

In regard to claim 13, Warner et al. disclose a guide lock that engages a portion of a medical instrument to inhibit rotation and axial movement, but fail to disclose the medical instrument including at least one notch and the guide lock being configured to be received in the notch to prevent movement of the medical instrument. Moctezuma De La Barrera et al. teach a guide lock (122) that engages a portion of a medical instrument to inhibit rotation and axial movement, wherein the medical instrument including at least one notch and the guide lock being configured to be received in the notch (Col. 6, lines 40 – 51). The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Because both Warner et al. and Moctezuma De La Barrera et al. teach means for locking a medical instrument within a receptacle, it would have been obvious to one skilled in the art at the time of the invention to substitute one guide lock for the other to achieve the predictable results of holding the medical instrument in a fixed relation to the receptacle.

### ***Conclusion***

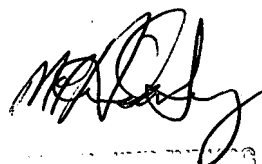
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JMLF

  
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